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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,724	02/29/2000	Geoffrey H. Gill	03188-P0001A	1108
24126 7590 07/06/2007 ST. ONGE STEWARD JOHNSTON & REENS, LLC 986 BEDFORD STREET STAMFORD, CT 06905-5619			EXAMINER TINKLER, MURIEL S	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 07/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/515,724	Applicant(s) GILL ET AL.	
	Examiner Muriel Tinkler	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413).
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application has been reviewed. Claims 1-19 are pending. The Examiner's response and rejection(s) are as stated below.

Response to Amendment

1. Claims 18 and 19 have been amended. The examiner has reviewed and accepted the amendments to Claims 18 and 19.

Response to Arguments

2. Applicant's arguments filed March 7, 2007 have been fully considered but they are not persuasive. The Applicant argues that Kravitz (US 6,029,150 A) does not disclose the use of an untraceable money code. The Examiner disagrees. Not only does Kravitz (US 6,029,150 A) teach the use of a money code, but also discloses it as prior art in the Background Section. Specifically, Kravitz (US 6,029,150 A) discloses an anonymous transaction of digital goods between a merchant and a customer in column 24 (line 66) through column 25 (line 3). Kravitz (US 6,029,150 A) also discloses the use of electronically emulating cash as prior art in the Background Section, specifically in column 2 (lines 23-31). Furthermore, Kravitz (US 6,029,150 A) discloses the use of electronic coins as prior art in the Background Section, specifically in column 4 (lines 15-40). In addition to the above references in Kravitz (US 6,029,150 A), there are several other publications that list anonymous electronic transactions between a

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customer and merchant, here are a few: Kravitz et al. (US 5,832,089 A), Simon (US 5,768,385 A), and Chaum (US 4,987,593 A).

3. The Applicant argues the inability to find in Kravitz (US 6,029,150 A), specifically within column 1-5, the act of: receiving a money code and money amount from a customer, assigning an associated money value to said money code, transmitting money code and money value to a financial institution, and the financial institution receiving the value. The Examiner points out the use of "Electronic Coin Based Systems" as described in Kravits (US 6,029,150 A) in column 3 (line 63) through column 4 (line 44). Looking specifically at the first paragraph, column 3 (line 63) through column 4 (line 3), Kravits (US 6,029,150 A) states, "There are numerous proposals for electronic payment systems that use electronic coins of fixed amounts as a means of exchange. A customer makes a withdrawal from his bank account and receives electronic coins from the bank. The customer can then use these coins to pay a merchant. The merchant can check the validity of the coins using cryptographic techniques. Then the merchant can deposit the coins into the bank."

4. The Examiner reminds the Applicant that although a reference may contain alternative embodiments in addition to teaching that relate directly to rejected Application, the alternative embodiments do not necessarily exclude or negate the teachings of the prior art reference.

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5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Double Patenting

6. Claims 1 and 9 of this application conflict with claim 1 of Application No. 11/436753. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

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by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

9. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/436753. Although the conflicting claims are not identical, they are not patentably distinct from each other because the content of Claim 1 in Application No. 11/436753 encompasses that of Claims 1 and 9 of this Application.

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11. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz (6029150 A), Jones et al.(5623547A) and Schenkler(US 6078902A).

17. Regarding claims 1 and 9: Kravitz discloses:

- a. a system for anonymously purchasing goods and services (col. 8, lines 1-15) over the Internet comprising: a communications system(col. 7, lines 15-55, col. 12, lines 30-60, Fig. 1 and 2);
- b. a customer computer linked to said communications system(col. 7, lines 15-55, col. 12, lines 30-60, Fig. 1 and 2);
- c. an issuer computer linked to said communications system(col. 7, lines 15-55, col. 12, lines 30-60, Fig. 1 and 2);
- d. a merchant computer linked to said communications system(col. 7, lines 15-55, col. 12, lines 30-60, Fig. 1 and 2);
- e. a financial institution computer linked to said communications system(paragraph 0028);

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- f. a money code, said money code containing no identification data related to a customer and being untraceable to said customer(col. 24, line 15-co1.25, line 5, fig. 1, 2);
- g. software executing on said customer computer for transmitting an order and said money code to said merchant computer over said communications system(Abstract, col. 7,line 1- col. 8, line 65);
- h. software executing on said merchant computer for receiving said order and money code from said customer computer(Abstract, Col. 8,lines 35-67); software executing on said issuer computer for receiving said money code and a money amount from a customer(cols. 1-5), assigning an associated money value to said money code based on said money amount received from the customer(cols. 1-5);
- i. transmitting said money code and associated money value to said financial institution computer over said communications system(cols. 1-5);
- j. software executing on said financial institution computer for receiving said money code and associated money value transmitted by said issuer computer and storing said money code and associated money value(cols..1-5);
- k. determining a money amount due for said order, and transferring said money code and money amount due to said financial institution computer over said communications system(cols. 1-5);
- l. software executing on said financial institution computer .for receiving said money code and money amount due from said merchant computer(cols. 1-5);

m. comparing said money amount due to said associated money value, and notifying said merchant computer of fund availability(cols. 1-5).

18. Kravitz does not disclose the exact term "money code". However, Jones et al. does teach a value transfer system which allows value to be transferred between electronic purses with a transaction code (money code) assigned to the money amount that uniquely identifies the transaction (Abstract, col. 2, lines 45-60, col. 3, lines 1-45); Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Kravitz to include the step of Jones et al. The motivation to combine these references is to efficiently transfer money from point to point.

19. Kravitz and Jones et al. fail to teach transmit money code from Merchant to customer over network. However, Schenkler does teach money code in place of electronic wallet and an electronic wallet is used to transmit money over a network. Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Kravitz and Jones et al to include the step of Schenkler. The motivation to combine these references is to facilitate funds transfer over a network.

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20. Claims 2,3,4,5,6,7,10,11,12,13,14,15 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz, Jones et al. and Schenkler as applied to claims 1 and 9 above, and further in view of Linehan(6327578B1) and Wong et al.(5913203A).

21. Regarding claims 2, 10 and 17: Kravitz, Jones et al. does not disclose customer computer for generating said money code, and inputting said money code and associated money value into said issuer computer; transmitting said money code and associated money value from said issuer computer to a financial institution computer over a communications system; transmitting an order and said money code from a customer computer to said merchant computer over said communication system; verifying fund availability by comparing said money amount due to said associated money value on said financial institution computer. Linehan discloses:

- a. a customer computer for generating said money code (col. 4, lines 15-25, i.e. "consumer's computer then sends over the internet network some consumer identity and authentication information" and col. 5, lines 50-67, i.e. "step of sending from a consumer's computer a start message")
- b. assigning an associated money value to a money code corresponding to a money amount surrendered to an issuer by a customer(Table 1 in col. 11, col. 13, lines 60-67 and col. 14, lines 1-15, claim 1, i.e. "issuing bank creating a reference number or value representing the consumer's credit or debit card number")

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- c. inputting said money code and associated money value into said issuer computer(col. 4, lines 10-20, "initiation message includes payment amount")
 - d. transmitting said money code and associated money value from said issuer computer to a financial institution computer over a communications system(col. 6, lines 50-65, i.e. "sending a settlement message")
 - e. transmitting an order and said money code from a customer computer to said merchant computer over said communication system(col. 4, lines 10-20, i.e. "sending from a customer's computer a start message over an internet network to a merchant's computer")
 - f. transmitting said money code and a money amount due from said merchant computer to said financial institution computer over said communications system(col. 6, lines 50-65, i.e. "sending a settlement message")
 - g. verifying fund availability by comparing said money amount due to said associated money value on said financial institution computer(col. 6, lines 10-16, i.e. "verifies that the consumer's account is active and has sufficient funds").
22. Kravitz, Jones et al. and Linehan does not explicitly disclose(s) that storing said money code on a storage device or said money code containing no identification data related to a customer and being untraceable to said customer. However, in col. 6, lines 45-60, col. 7, lines 55-63 thereof, Wong et al. disclose(s) the user selects the level of anonymity and traceability desired and that once the pseudo cash unit is generated, a record generation means generates an active record associated with the pseudo cash

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unit and the fixed monetary value and stores the active record in records storage medium, which is preferably some type of electronic data storage device. It would be obvious to one of ordinary skill in the art to modify the invention of Kravitz, Jones et al. and Linehan based on the teachings of Wong et al. The motivation to combine these references is to enable the selection of anonymous, untraceable transaction to conduct transactions anonymously ensuring the consumer's identity remains confidential, and to use a storage device to store codes to ensure codes are available when needed.

23. Regarding claims 3 and 11: Linehan disclose generating a personal identification code to be associated with said money code for controlling access and use of said money code (col. 2, lines 45-50, i.e. "password", col. 4, lines 15-25, i.e. "consumer identity and authentication information" and col. 7, lines 55-67, "the user's identification and authentication information and the merchant's initiation message" and claim 1, i.e. "consumer identity and authentication information").

24. Re claims 7 and 15: Linehan disclose communications system comprises the Internet (col. 5, lines 55-60).

25. Re claims 8 and 16: Linehan disclose merchant computer for operating and maintaining an Internet website, accessible by the customer, for facilitating commercial transactions between the customer and a merchant(col. 2, lines 40-45, i.e. "Web server").

26. Re claims 4 and 12: Linehan does not explicitly disclose(s) that encrypting said money code. However, in col. 2, lines 35-67 thereof, Wong et al. disclose(s) that the "Digicash" or "ecash" system turns a user's or buyer's hard drive on a PC into a purse. To use this system, one first establishes an account with a bank. To obtain digicash or ecash, the user creates a series of numbers that will represent a mixture of coins or money bills in various denominations according to the user's own wishes. This request for digicash is then sent to the bank, which deducts the total amount requested from the user's existing valid account. The bank then sends the user an equivalent amount of ecash as an encrypted email message containing a series of numbers. Each number corresponds to a specified amount of money. Thus, it would have been within the level of ordinary skill in the art to encrypt a code to ensure anonymity in the transaction.

27. Re claims 5 and 13: Linehan disclose customer computer for requesting said personal identification code from the customer, retrieving said money code from said storage device(col. 4, lines 10-25, i.e. "consumer's computer starts message from digital wallet" and lines 30-35, col. 7, lines 55-67, i.e. "the merchant sends to the customer computer, the wallet initiation message" and "then in step 306, the consumer's wallet is started"), and said money code based on said personal identification code prior to transmitting said money code to said merchant computer(col. 5, lines 55-60, i.e. "sending from a consumer's computer a start message over an internet network to a merchant's computer").

28. Linehan does not explicitly disclose decrypting an item after it reaches its destination. However, this is well known in the computer art. Thus, it would have been obvious to one of ordinary skill in the art to employ decryption to unencrypt a code or message when it reaches the merchant to get the benefit of encryption in transit to preserve the anonymity of data in transit.

29. Re claims 6 and 14: Linehan discloses:

- a. merchant computer for requesting said personal identification code from the customer upon receipt of said order and money code (col. 5, lines 55-67, i.e. "the merchant's computer replies to consumer's computer", and col. 6, lines 45-67, i.e. "once the merchant has received the authorization token from the issuer")
- b. customer computer for requesting said personal identification code from the customer and transmitting said personal identification code to said merchant computer (claim 1, i.e. "sending from the consumer's computer consumer identity and authentication information")
- c. said merchant computer for receiving said personal identification code from the customer and transmitting said personal identification code in addition to the money code and money amount due to said financial institution computer over said communications system (col. 4, lines 10-25, i.e. "merchant sends a message, including reference value to acquirer gateway operating on behalf of an acquirer bank" and col. 6, lines 45-67, i.e. "once the merchant has received

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the authorization token from the issuer gateway, the merchant completes the sales transaction")

d. said financial institution computer for receiving said money code, money amount due, and personal identification code and decrypting said money code using said personal identification code prior to determining fund availability(col. 6, lines 45-67, i.e. "once the merchant has received the authorization token from the issuer gateway, the merchant completes the sales transaction", and col. 6, lines 5-20, i.e. "verifies customer account is active and has sufficient funds and/or credit to support the payment amount.").

30. Linehan does not explicitly disclose that software executing on various computers. However, Linehan does indicate browser in col. 1, lines 43-46 and since computers cannot operate without software, it would have been obvious to one of ordinary skill in the art to employ software applications on a computer to get the benefit of the four-party communications payment system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

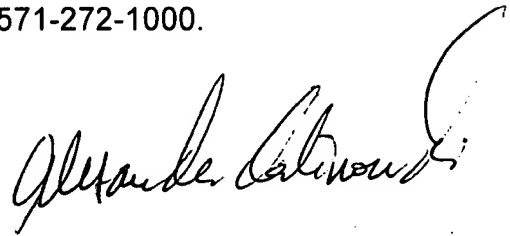
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT

June 22, 2007



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